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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,410	03/08/2001	Michael S. Bender	843161-214	2889
23879	7590	04/05/2005	EXAMINER	
BRIAN M BERLINER, ESQ O'MELVENY & MYERS, LLP 400 SOUTH HOPE STREET LOS ANGELES, CA 90071-2899			SONG, HOSUK	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,410

Applicant(s)

BENDER, MICHAEL S.

Examiner

Hosuk Song

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-12 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-12,15-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-2,5-9,11-12,15-19,21-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Stoltz et al.(US 6,615,264).

Claim 1: Stoltz discloses presenting smart card to a computing device in (fig.2 and col.8,lines 7-16). Stoltz discloses extracting a token ID from smart card and obtaining a token type by one of extracting the token type from smartcard and consulting a configuration file in (col.8,lines 34-36 and col.18,lines 6-18). Stoltz disclose using token ID and token type to identify smart card in (col.18,lines 10-18).

Claim 2: Stoltz discloses establishing a communication channel between computing device and a remote computer in (fig.2).

Claims 5,7,8: Stoltz disclose configuration file resides on remote computer and probe order file to obtain a path for configuration file in (col.8,lines 31-44).

Claim 6: Stoltz discloses remote computer comprises a server in (fig.2).

Claim 9: Stoltz discloses computing device comprises a human interface device in (fig.2 and col.5,lines 62-67).

Claim 11: Stoltz discloses presenting smart card to a computing device in (fig.2 and col.8,lines 7-16). Stoltz discloses extracting a token ID from smart card and obtaining a token

type by one of extracting the token type from smartcard and consulting a configuration file in (col.8,lines 34-36 and col.18,lines 6-18). Stoltz disclose using token ID and token type to identify smart card in (col.18,lines 10-18). Computing device is disclosed by Stoltz in (fig.2)

It is inherent in system of Stoltz to include computer readable program code or software in order to carry out such functions.

Claims 12,16: Stoltz discloses all the limitation, see claims 1-2,6 above. It is inherent in system of Stoltz to include computer readable program code or software in order to carry out such functions as token ID extraction,smart card identification,communication establishment between two terminals.

Claims 15,17,18: Stoltz disclose configuration file resides on remote computer and probe order file to obtain a path for configuration file in (col.8,lines 31-44).

Claim 19: Stoltz discloses computing device comprises a human interface device in (fig.2 and col.5,lines 62-67). Computer program inherency is discussed in claims 11-14.

Claim 21: Stoltz discloses smart card configured to be presented to a computing device in (fig.2 and col.8,lines 7-16). Stoltz discloses extracting a token ID from smart card and obtaining a token type by one of extracting the token type from smartcard and consulting a configuration file in (col.8,lines 34-36 and col.18,lines 6-18). Stoltz disclose using token ID and token type to identify smart card in (col.18,lines 10-18).

Claim 22: Stoltz discloses a communication channel between computing device and a remote computer wherein token type is found on remote computer in (fig.2 and col.18,lines 10-18).

Claim 23: Stoltz discloses extracting a token type from smart card in (col.8,lines 34-36 and col.18,lines 6-18).

Claim 26: Stoltz discloses remote computer comprises a server in (fig.2).

Claims 24,25,27,28: Stoltz disclose configuration file resides on remote computer and probe order file to obtain a path for configuration file in (col.8,lines 31-44).

Claim 29: Stoltz discloses computing device comprises a human interface device in (col.5,lines 62-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 10,20,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoltz et al.(US 6,615,264) in view of Schlumberger(Schlumberger Unveils E-Cash Enabled Smart loyalty Card. New wire).

Claims 10,20,30: Stoltz does not specifically disclose MicroPayflex smart card. Schlumberger discloses MicroPayflex smart card. It would have been obvious to person of ordinary skill in the art at the time invention was made to employ Micropayflex smart card as disclosed in Schlumberger with smart card taught in Stoltz in order to conduct fast and secure transaction management such as home banking,e-commerce and identification and access control.

Claim Objections

3. Claim 15 objected to because of the following informalities: Claim 14 is dependent on cancelled claim 14. For purpose of examination, examiner assumes claim 15 is dependent on claim 12 . Appropriate correction is required.

Response to Applicant's Arguments

4. Previous grounds of rejection based on White patent is withdrawn in view of applicant's arguments in the Amendment filed on 11/29/2004. However, newly discovered prior art has necessitated new grounds of rejection. Delay in citation of newly discovered prior art is regretted. See new rejections above.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosuk Song whose telephone number is 571-272-3857. The examiner can normally be reached on Tue-Fri 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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